

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 24, 25, 27, 29 and 30 will have been amended while claims 31 and 32 will have been newly submitted for consideration by the Examiner. Thus, claims 24-32 are pending for consideration by the Examiner.

In view of the above, Applicants respectfully request reconsideration of the outstanding rejections of all the claims pending in the present application and an indication of the allowability thereof. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants would like to express their appreciation to the Examiner for the detailed Advisory Action (dated April 2004) provided, in response to which a Request for Continued Examination was filed on May 14, 2004.

Turning to the merits of the action issued on July 2, 2004, the Examiner has rejected claims 24-27, and 30 under 35 U.S.C § 102(e) as being anticipated by SAITO et al. (U.S. Patent 6,351,316). The Examiner also has rejected claim 29 under 35 U.S.C § 102(e) as being anticipated by FEDER et al. (U.S. Patent 5,872,845). Further, the Examiner has rejected claim 28 under 35 U.S.C § 102(e) as being unpatentable by SAITO et al. (U.S. Patent 6,351,316) in view of FEDER (U.S. Patent 5,872,845).

As noted above, Applicants have amended claims 24, 25, 27, 29 and 30 and submitted new claims 31 and 32. Thus, claims 24-32 remain pending for consideration. Applicants respectfully traverse the above rejections based on pending claims 24-32 and

will discuss said rejection with respect to the pending claims in the present application as will be set forth hereinbelow.

Applicants' claims 24-26 relate to a server apparatus connected with a transmitting facsimile apparatus and a receiving facsimile apparatus via the Internet. The server apparatus stores reception capabilities regarding a type of facsimile data that the receiving facsimile can receive. The reception capabilities are distinct from the facsimile data. The server apparatus receives facsimile data from the transmitting facsimile apparatus, transforms the received facsimile data into a type of facsimile data that the receiving facsimile apparatus can receive, based on the stored reception capabilities of the receiving facsimile apparatus, and transmits the transformed facsimile data to the receiving facsimile apparatus. Claim 30 recites a related method.

In direct contrast, SAITO et al. relate to an Internet facsimile apparatus which, when a received e-mail data can not be printed, transfers the received e-mail data to another information terminal device. When the Internet facsimile apparatus receives an e-mail (ST 601 of Fig. 6), the Internet facsimile apparatus decides whether or not the received e-mail data is printable. For example, the Internet facsimile apparatus decides (ST 603) whether or not the received e-mail data is printable, based on whether or not the received e-mail data is in a TIFF format (see column 4, lines 34-43 of SAITO et al.). When the received e-mail data is not printable, the Internet facsimile apparatus decides whether the received e-mail data can be transferred to another information terminal device (ST 607 of Fig. 6). For example, the decision to transfer is made, based on

whether or not the another information terminal device is prepared as a transfer destination (see column 4, lines 54-61 of SAITO et al.). When the received e-mail data can be transferred to the another information terminal device, the Internet facsimile apparatus transfers the received e-mail data to the another information terminal device (ST 617 of Fig. 7). On the other hand, only when the e-mail data is determined to be printable (YES, step ST 603) is a format conversion performed.

However, SAITO et al. do not have the claimed memory which stores reception capabilities regarding a type of facsimile data that the receiving facsimile apparatus can receive, the reception capabilities being distinct from facsimile data. Although SAITO et al. register a printing requirement in a printing requirement table (see column 4, lines 34-43 of SAITO et al.), the printing requirement indicates whether the Internet facsimile apparatus that has received the e-mail data can print the received e-mail data.

However, it is the "another information terminal device" of SAITO et al. that corresponds to the receiving facsimile apparatus of the present claims. In other words, the printing requirement indicates capabilities of the Internet facsimile apparatus that has received the e-mail data, but does not indicate the capabilities of the another information terminal device to which the e-mail data is to be transferred. Thus, SAITO et al. do not disclose the claimed memory which stores capabilities regarding facsimile data that the receiving facsimile apparatus can receive, the capabilities distinct from facsimile data.

Yet further the present invention relates to a server that is connected to a transmitting facsimile apparatus and a receiving facsimile apparatus. In contrast, SAITO

P18051.A14

et al. is directed to the receiving apparatus itself. In particular, and contrary to the Examiner's assertion in the outstanding Official Action, column 3, lines 64-67 and column 4, lines 1-12 of SAITO et al. do not disclose a server including a memory that stores capabilities regarding the facsimile data that the receiving facsimile apparatus can receive. The cited portions of the SAITO et al. disclosure merely refer to the various data conversions that take place within the receiving facsimile apparatus as performed by converting section 26, facsimile section 27 as illustrated in Fig. 3. However, SAITO et al. does not disclose either a memory as recited in these claims or a controller that transforms the received facsimile data into a type of facsimile data that the receiving (i.e., different) facsimile apparatus can receive. According to the recitations of Applicants claim, the server transforms data received by the server into a type of data that a receiving facsimile apparatus, that is distinct from the server, but which is connected to the server via the Internet, can receive based on the reception capabilities stored in memory. It is respectfully submitted that this feature is not taught, disclosed nor rendered obvious by SAITO et al.

Further, SAITO et al. does not transform received facsimile data into a type of facsimile data that a receiving facsimile apparatus can receive, based on capabilities stored in a memory, since SAITO et al. does not have at least the above-noted memory, as recited. As explained above, SAITO et al. transfers the received e-mail data to the "another information terminal device", when the received e-mail data is not in the TIFF format and when the another information terminal device is prepared (i.e., is available to

print the e-mail data). However, SAITO et al. does not teach transforming the received e-mail data into a different type data, based on capabilities of a different apparatus stored in a memory. Thus, SAITO et al. does not disclose the claimed controller which transforms the received facsimile data into a type of facsimile data that the receiving facsimile apparatus can receive, based on the reception capabilities stored in the memory.

Therefore, the pending claims are clearly distinguished from SAITO et al. It is respectfully submitted that the features recited in Applicants' claims 24-26 and 30 are not taught in SAITO et al. cited by the Examiner.

Applicants undersigned representative would also wish to make of record a telephone interview conducted regarding the outstanding Official Action in the present application on August 4, 2004. During the above-noted telephone interview, the various shortcomings of the SAITO et al. reference with respect to the features of the present application were set forth, substantially as noted above. At the conclusion of the interview, the Examiner requested Applicants to more clearly define the nature of the capabilities stored in the memory. Applicants representative asserted that the recitation of "capabilities regarding facsimile data that the receiving apparatus can receive" quite accurately and distinctly defines the data stored in the memory. Nevertheless, in order to accommodate the Examiner's concerns, Applicants have, by the present Response, yet even further defined the memory as being "configured to store reception capabilities regarding a type of facsimile data that the receiving apparatus can receive, the reception capabilities being distinct from facsimile data".

The Examiner indicated that if the capabilities stored in the memory are more clearly defined, the claim would appear to overcome the SAITO et al. reference subject, of course, to an update search. Moreover, during the above-noted interview, the proposed amendment was discussed with the Examiner and the Examiner indicated that it was adequate to clarify the data stored in the memory in such a fashion as to overcome the teachings of the SAITO et al. reference.

Applicants' claims 27 and 31 also relate to a server apparatus that transmits and receives an e-mail with a predetermined address. The e-mail with the predetermined address indicates the capabilities of the Internet facsimile apparatus to be stored in the memory of the server apparatus.

As explained above, SAITO et al. transfers the received e-mail data to another information terminal device when a received e-mail data cannot be printed. However, SAITO et al. does not disclose an e-mail with a predetermined address indicating the capabilities of the Internet facsimile apparatus to be stored in the memory of the server apparatus. Thus, claims 27 and 31 are clearly distinguished from SAITO et al.

Therefore, it is respectfully submitted that the features recited in Applicants' claims 27 and 31 are not taught in SAITO et al. cited by the Examiner.

Applicants' claims 29 and 32 relate to an Internet facsimile that transmits and receives an e-mail with a predetermined address. The e-mail with the predetermined address indicates the capabilities of the Internet facsimile apparatus to be stored in the

server apparatus. The rejection of claim 29 as anticipated by FEDER is respectfully traversed.

In contrast to the features of claim 29, FEDER relates a system which includes a first fax machine 110, a first interface apparatus 120, a first server 103, a packet-switched digital communications network 140, a second server 150, a second interface apparatus 160, and a second fax machine 170 (see column 4, lines 41-51 of FEDER). Fig. 2A of FEDER also describes components of the first interface apparatus 120 (see column 5, lines 47-55 of FEDER). Further, column 8, lines 37-68 of FEDER describes a data structure for a file which is transmitted from the interface 120 to local server 130 and explains a standard Internet e-mail protocol as an example. However, FEDER does not transmit, to the server by e-mail, capabilities regarding facsimile data that the Internet facsimile apparatus can receive, and does not store the capabilities of the Internet facsimile apparatus in the server apparatus. Thus, FEDER does not disclose the e-mail with the predetermined indicating the capabilities of the Internet facsimile apparatus to be stored in the server apparatus.

Applicants' claim 29 recites and requires a controller that transmits an e-mail to the server, the e-mail containing reception capabilities regarding a type of facsimile data that the Internet facsimile apparatus can receive. The e-mail indicates the reception capabilities of the Internet facsimile apparatus that are to be stored in the server apparatus. However, according to the teachings of FEDER, the server 550, when it receives a message re-encodes it in several formats and stores it in memory. When the

called facsimile machine transmits the DIS signal, the server sends the message in the appropriate format and erases the others (column 10, lines 26-31). Thus, according to the teachings of FEDER, the server does not store capabilities of the facsimile machine but stores the data in various formats. Thus, it follows that the controller of the Internet facsimile apparatus does not transmit reception capabilities to the server regarding a type of facsimile data that the Internet facsimile apparatus can receive to be stored in the memory of the server apparatus.

Applicants invention, as recited in claim 29, requires an e-mail message from the facsimile apparatus to the server that sets forth reception capabilities regarding a type of facsimile data that the facsimile apparatus can receive. Further, such reception capabilities are stored in the server apparatus to later be used to appropriately transform received facsimile data. This is in direct contrast with the FEDER device that stores data in a plurality of formats in the server and then, upon appropriate determination, sends the appropriate format to the receiving apparatus and erases the others. Applicants invention has the additional benefit of not requiring that the conversion of received facsimile data into a plurality of formats and the storing of the data in the plurality of formats. Applicants invention merely stores reception capabilities and, based on the reception capabilities stored transforms received data into the format appropriate for the receiving apparatus.



Therefore, the pending claims 29 and 32 are clearly distinguished from FEDER. It is respectfully submitted that the features recited in Applicants' claims 29 and 32 are not taught in FEDER cited by the Examiner.

Regarding the § 103 rejection of claim 28, as explained in the above discussion of claims 27 and 29, neither SAITO et al. nor FEDER contain a disclosure about the e-mail with the predetermined address indicating the capabilities of the Internet facsimile apparatus, to be stored in the server apparatus.

Therefore, it is respectfully submitted that the features recited in Applicants' claim 28 are also not rendered obvious by SAITO et al. in combination with FEDER cited by the Examiner.

Accordingly, for each of these reasons, and certainly for all of these reasons, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection and an indication of the allowability of all the claims pending in the present application in due course.

SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have resubmitted the claims for consideration by the Examiner. With respect to the pending claims, Applicants have pointed out the features thereof and have contrasted the features of the submitted claims with the disclosures of the cited reference. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully request an indication of the allowability of all the claims pending in the present application in due course.

By the present Response, Applicants have amended several claims in accordance with the Examiner's suggestion while not acquiescing that such amendment is required to define over the references. Applicants have further submitted several additional claims for consideration by the Examiner and have pointed out numerous bases for the patentability of the claims.

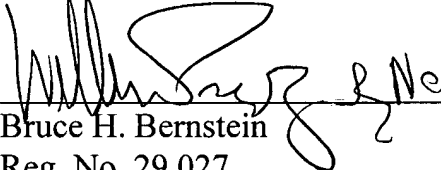
Applicants have further made of record a telephone interview conducted between Applicants undersigned representative and the Examiner and have thanked the Examiner for his cooperation during the above-noted interview. Applicants further indicated that the Examiner, during the above-noted interview, accepted the arguments and distinctions made between the cited references and the recitations of the claims in the present application.

P18051.A14

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
Yoshihiro IDA et al.

  
Bruce H. Bernstein  
Reg. No. 29,027

September 3, 2004  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191